

**REMARKS**

The above amendment with the following remarks is submitted to be fully responsive to the Final Office Action of May 19, 2008. Claims 1-29 were pending in the present application prior to the above amendment. In the present amendment, claims 1, 9, 26 and 27 are amended, with claims 2, 6-8, 19, and 23-25 cancelled, and with claim 30 added. No new matter is introduced (see, e.g., paragraphs [0217]-[0219] of the published Specification and original claims 2, 6-8, 19, and 23-26). Reconsideration in view of the above amendments and following remarks is respectfully requested.

First, Applicants wish to thank Examiner Wong and SPE Kramer for the personal interview conducted with Applicants' undersigned attorney on June 9, 2008. During the discussions, although no agreement was reached, Applicants' undersigned attorney noted some of the novel features of the invention, as set forth in detail below.

In response to the 35 U.S.C. § 112 rejection of claims 25-26 based on indefiniteness, claim 25 has been cancelled and claim 26 has been amended. No new matter is introduced. Accordingly, the pending claims are in compliance with 35 U.S.C. § 112 and no further rejection on such a basis is anticipated. If, however, the Examiner disagrees, the Examiner is invited to contact the undersigned attorney, who will be happy to work with the Examiner in a joint effort to derive mutually satisfactory claim language.

The present office action rejects claims 1-29, of which claims 1 and 27 are independent claims, based on the applied references, (1) Checchio (USP 6,052,675), (2) yellowpages.com ("Orix Global Communications Launches New Web Site"), (3) In Re Venner, (4) Luneau et al. (USP 5,848,161), (5) Malek (USP 4,920,567), (6) McAllister (USP 5,513,250), (7) Northington et al. (USP 6,128,602), (8) Pickering (USP 5,483,445), (9) Flitcroft et al. (USPA 20030028481), and (10) Lawlor et al. (USP 5,220,501). These rejections are respectfully overcome because the applied references, alone or in combination, fail to disclose, teach or suggest all of the features recited in the claims. For example, independent claim 1, as amended, recites (emphasis added):

A method for managing a financial transaction of a user at both  
online and offline merchants, comprising:  
    providing via a server an identification of both online and offline  
merchants for selection by a user;

authenticating the user at the server via a device of the user while the user is at an online or offline site of the merchant;

**transmitting via the user device directly to a financial institution activation information for activating a reusable, pre-existing, unaltered and permanent credit or debit card account number of the user from the user device to the financial institution for processing financial transactions, while the user is authenticated and based on a selection of the merchant by the user on the server;**

submitting a payment request including the reusable, pre-existing, unaltered and permanent credit or debit card account number to the financial institution from the merchant, while the reusable, pre-existing, unaltered and permanent credit or debit card account number is activated; and

de-activating the reusable, pre-existing, unaltered and permanent credit or debit card account number after the payment request is processed by the financial institution, wherein the financial institution only accepts and processes payment requests received from merchants while the reusable, pre-existing, unaltered and permanent credit or debit card account number is activated, and the financial institution declines payment requests while the reusable, pre-existing, unaltered and permanent credit or debit card account number is de-activated,

wherein **the payment request comprises a recurring payment request or a partial payment request and the method further comprises processing the partial payment request including generating subsequent activation and deactivation information by the server based on the selection of the merchant by the user for processing remaining payments or processing the recurring payment request including generating subsequent activation and deactivation information by the server based on the selection of the merchant by the user for processing recurring payments, and**

**the subsequent activation information does not require the authenticating step.**

Independent claim 26, as amended, recites (emphasis added):

A computer program product for managing a financial transaction of a user at both online and offline merchants, including one or more computer readable instructions embedded on a computer readable medium and configured to cause one or more computer processors to perform the steps of:

providing via a server an identification of both online and offline merchants for selection by a user;

authenticating the user at the server via a device of the user while the user is at an online or offline site of the merchant;

**transmitting via the user device directly to a financial institution activation information for activating a reusable, pre-existing, unaltered and permanent credit or debit card account number of the user from the user device to the financial institution for processing financial transactions, while the user is authenticated and based on a selection of the merchant by the user on the server;**

submitting a payment request including the reusable, pre-existing, unaltered and permanent credit or debit card account number to the financial institution from the merchant, while the reusable, pre-existing, unaltered and permanent credit or debit card account number is activated; and

de-activating the reusable, pre-existing, unaltered and permanent credit or debit card account number after the payment request is processed by the financial institution, wherein the financial institution only accepts and processes payment requests received from merchants while the reusable, pre-existing, unaltered and permanent credit or debit card account number is activated, and the financial institution declines payment requests while the reusable, pre-existing, unaltered and permanent credit or debit card account number is de-activated,

wherein **the payment request comprises a recurring payment request or a partial payment request and the method further comprises processing the partial payment request including generating subsequent activation and deactivation information by the server based on the selection of the merchant by the user for processing remaining payments or processing the recurring payment request including generating subsequent activation and deactivation information by the server based on the selection of the merchant by the user for processing recurring payments, and**

**the subsequent activation information does not require the authenticating step.**

Independent claim 27, as amended, recites (emphasis added):

A system for managing a financial transaction of a user at both online and offline merchants, the system comprising:

means for providing via a server an identification of both online and offline merchants for selection by a user;

means for authenticating the user at the server via a device of the user while the user is at an online or offline site of the merchant;

means for **transmitting via the user device directly to a financial institution activation information for activating a reusable, pre-existing, unaltered and permanent credit or debit card account number of the user from the user device to the financial institution for processing financial transactions, while the user is authenticated and based on a selection of the merchant by the user on the server;**

means for submitting a payment request including the reusable, pre-existing, unaltered and permanent credit or debit card account number to the financial institution from the merchant, while the reusable, pre-existing, unaltered and permanent credit or debit card account number is activated; and

means for de-activating the reusable, pre-existing, unaltered and permanent credit or debit card account number after the payment request is processed by the financial institution, wherein the financial institution only accepts and processes payment requests received from merchants while the reusable, pre-existing, unaltered and permanent credit or debit card account number is activated, and the financial institution declines payment requests while the reusable, pre-existing, unaltered and permanent credit or debit card account number is de-activated,

wherein **the payment request comprises a recurring payment request or a partial payment request and the method further comprises processing the partial payment request including generating subsequent activation and deactivation information by the server based on the selection of the merchant by the user for processing remaining payments or processing the recurring payment request including**

**generating subsequent activation and deactivation information by the server based on the selection of the merchant by the user for processing recurring payments, and  
the subsequent activation information does not require the means for authenticating.**

Thus, the inventions of independent claims 1 and 26-27 include the novel features of a method, computer program product and system for managing a financial transaction of a user at both online and offline merchants, including transmitting via a user device directly to a financial institution activation information for activating a reusable, pre-existing, unaltered and permanent credit or debit card account number of a user from the user device to the financial institution for processing financial transactions, while the user is authenticated and based on a selection of a merchant by the user on a server, wherein a payment request comprises a recurring payment request or a partial payment request and processing of the partial payment request includes generating subsequent activation and deactivation information by the server based on the selection of the merchant by the user for processing remaining payments or processing of the recurring payment request includes generating subsequent activation and deactivation information by the server based on the selection of the merchant by the user for processing recurring payments, and the subsequent activation information does not require authenticating. Advantageously, the inventions of independent claims 1, 26 and 27 allow processing of partial/recurring payments, with an initial activation being generated by a user device and sent directly to a financial institution and with subsequent activations for partial/recurring payments being automatically generated without a need for activation by the user device, as compared to the applied references.

By contrast, the Office Action correctly admits that Checchio does not provide merchant selection. Accordingly, a consumer must pre-authorize every vendor and dollar amount transaction, before a transaction can be approved with the system of Checchio and even when combined with the yellowpages.com, which merely provides merchant listings. In addition, it would not obvious to one of ordinary skill in the art to incorporate merchant selection into the system Checchio, based on such a general disclosure of merchant listings in yellowpages.com.

Further, the applied references, alone or in combination, do not disclose, teach or suggest the novel concept of transmitting via a user device directly to a financial institution

activation information for activating a reusable, pre-existing, unaltered and permanent credit or debit card account number of a user from the user device to the financial institution for processing financial transactions, while the user is authenticated and based on a selection of a merchant by the user on a server, wherein a payment request comprises a recurring payment request or a partial payment request and processing of the partial payment request includes generating subsequent activation and deactivation information by the server based on the selection of the merchant by the user for processing remaining payments or processing of the recurring payment request includes generating subsequent activation and deactivation information by the server based on the selection of the merchant by the user for processing recurring payments, and the subsequent activation information does not require authenticating, as recited in independent claims 1 and 26-27.

The present Office Action relies on Pickering, col. 8, lines 43-59, which includes the general concept of partial payments, and on Lawlor et al., col. 34, lines 29-34, which includes the general concept of recurring payments. However, as noted above, it would not be obvious to modify the system of Checchio in view of yellowpages.com, and much less to include recurring or partial payment processing, including generating subsequent activation and deactivation information, wherein the subsequent activation information does not require authenticating, based on the general disclosures of Pickering and Lawlor et al.

The remaining references, In Re Venner, Luneau et al., Malek, McAllister, Northington et al., and Flitcroft et al. fail to cure the noted deficiencies in Checchio, yellowpages.com, Pickering and Lawlor et al. Thus, the applied references, Checchio, yellowpages.com, In Re Venner, Luneau et al., Malek, McAllister, Northington et al., Pickering, Flitcroft et al., and Lawlor et al., alone or in combination, do not disclose, teach or suggest the noted features or advantages of the inventions of independent claims 1, 26 and 27.

With respect to the rejection of claim 4 based on In Re Venner, Applicants submit that “to make automatic is obvious,” as asserted in the present Office Action, is not a proper application of In Re Venner, which holds that:

It was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

The present Office Action fails to show what manual activity is merely being made automatic. Applicants submit that the feature of activation information being automatically transmitted to a financial institution when a user logs into a server, as recited in claim 4, is not obvious over the applied references, even in view of In Re Venner.

With respect any rejections based on Official Notice, Applicants traverse such rejections and request the Examiner to provide prior art showing such allegedly well known features, and reasons for combining such prior art with the applied references to arrive at the claimed invention.

The dependent claims are allowable over the applied references, alone or in combination, on their own merits and for at least the reasons argued above with respect to independent claims 1 and 26-27.

The present amendment is submitted in accordance with the provisions of 37 C.F.R. §1.116, which after Final Rejection permits entry of amendments placing the claims in better form for consideration on appeal. As the present amendment is believed to overcome outstanding rejections under 35 U.S.C. § 103 by incorporating features from the dependent claims, without raising new issues requiring the Examiner's further search and/or consideration, the present amendment places the application in better form for consideration on appeal. It is therefore respectfully requested that 37 C.F.R. §1.116 be liberally construed, and that the present amendment be entered.

In view of the foregoing, it is submitted that the present application is in condition for allowance and a notice to that effect is respectfully requested. However, if the Examiner deems that any issue remains after considering this response, the Examiner is invited to contact the undersigned attorney to expedite the prosecution and engage in a joint effort to work out a mutually satisfactory solution.

Respectfully submitted,

/Carlos R. Villamar, Reg. # 43,224/  
Carlos R. Villamar  
Reg. No. 43,224

Customer No. 25570  
**Roberts Mlotkowski Safran & Cole, P.C.**  
7918 Jones Branch Drive  
Suite 500  
McLean, VA 22102  
Phone: 703.584.3267  
Cell: 703.623.4122  
Fax: 703.848.2981  
July 18, 2008